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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,955	02/20/2002	Robert Swift	3728-0103P	3035

2292 7590 07/14/2004

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EXAMINER

CHIN, PAUL T

ART UNIT	PAPER NUMBER
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3652

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,955

Applicant(s)

SWIFT ET AL.

Examiner

PAUL T. CHIN

Art Unit

3652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12, 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 13-20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's amendment filed April 2, 2004, and the arguments have been fully considered and are persuasive in light of the amended claims. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ward (5,359,942) or Brice (4,776,415). Claims 13-20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 13-16, 19, 20, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ward (5,359,942) and claims 13, 14, 17, and 18 also are rejected under 35 U.S.C. 102(b) as being anticipated by Brice (4,776,415) and claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brice's apparatus (4,776,415) in view of Ward's apparatus (5,359,942). However, claims 1-12, 21, and 22 are allowed. A final office action follows as below.

Drawings

2. The substitute drawing was received on April 2, 2004, and the drawing (Fig. 2C) has been approved.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13-20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The exact meaning of the claimed language "*a manually operated control switch for transmitting power to the pump*" (claim 13, lines 11-12) is not clearly understood as to how the switch is used for transmitting power to the pump. It is understood that the necessary power for the pump is provided by a power source (28) and the claimed language is misleading.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 13-16, 19, 20, and 23, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by **Ward (5,359,942)**.

Ward (5,359,942), as best understood, discloses an apparatus for remotely actuating a hydraulic motor of a hydraulic device assembly comprising a frame (Fig. 2), a plurality of wheels, and other hydraulic system (28,32,55), the apparatus comprising a platform (30), which can be considered as a mounting device, substantially supported by the hydraulic device assembly (Fig. 1), a hydraulic pump (41) located on the mounting device for supplying pressurized fluid to the hydraulic motor (see Col 5, lines 1-6) of the hydraulic device (55), a fluid (air) motor (36), which is a driving device, located on the mounting device for the hydraulic pump, a control device (40) (see Fig. 1), located on the mounting device, having a receiver, or an antenna (87) (Col 9, lines 1-19) for receiving a control signal and having a manually operated control switch (see Fig. 4, and Col 10, lines 60-66)

for transmitting power to the pump whereby the hydraulic motor of the hydraulic device (55) may be remotely controlled by the control signal (operator control station 85) (see from Col 9, line 1, to Col 10, line 66).

Re claim 14, Ward's apparatus (5,359,942) shows a wireless transmitter located remotely (in the operator station 85) from the receiver for sending the control signal (see Col 9, lines 1-28).

Re claim 15, Ward's apparatus (5,359,942) also shows that the hydraulic motor is the hydraulic cylinder (see Col 5, lines 1-6).

Re claim 16, the hydraulic cylinder (55) of Ward's apparatus (5,359,942) opens a door (47,48) (Fig. 2) of a container (21) to dump contents such as road bed ballast (Col 4, lines 7-12) from the container.

Re claims 19 and 20, Ward's apparatus (5,359,942) shows the mounting device is an enclosure (20) (21,25,26,30) enclosing the hydraulic pump (41), the driving device (36), and the control device (40) (see Fig. 1) wherein the hydraulic device comprises a bottom dumping container (28,32) (see Fig. 2).

Re claim 23, Ward's apparatus (5,359,942) shows the manually operated control switch(s) (97,97) (92) (see Fig. 4) comprise open, closed, and off positions.

7. Claims 13,14,17, and 18, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by **Brice (4,776,415)**.

Brice (4,776,415), as best understood, discloses a remotely control apparatus for actuating a pair of hydraulic cylinders (34,36), comprising a tie bar (56), a mounting plate

(58), and a tray (78), which can be considered as a mounting device; a hydraulic device (2) wherein the mounting device is supported by the hydraulic device (see Figs. 2 and 3); a hydraulic pump (42) (Fig. 2) located on the mounting device for supplying pressurized fluid; an electric motor (44,46), which are driving devices, located on the mounting device for the hydraulic pump (Col 3, lines 55-58); a control device located on the mounting device (Fig. 2), having a receiver (76) having an antenna (86) for receiving a control signal and having a manually operated control switch or button (116) (see Fig. 2) for substantially transmitting operating power to the pump (see Col 3, lines 55-62, and Col 4, lines 16-22) whereby the hydraulic cylinders (34,36) may be remotely controlled by the control signal.

Re claim 14, Brice's apparatus (4,776,415) shows a wireless transmitter (88) (Fig. 3) located remotely from the receiver (76) for sending the control signal.

Re claims 17 and 18, Brice's apparatus (4,776,415) also shows that the driving device is an electric motor (44,46) (Col 2, lines 40-47) and the electric power source is a battery (72) (Fig. 2) (Col 2, lines 64-66). It is pointed out that Brice's apparatus (4,776,415) contains all the structural elements as broadly as recited in the above claims while the intended use (i.e. *for remotely actuating a hydraulic motor of a hydraulic device*) is not patentably significant. The phrase "a hydraulic motor" is not positively recited in the body of the claim and the functional limitation of "*supplying pressured fluid to the hydraulic motor*" is not given patentably weight and the limitation is not patentably significant. Brice's apparatus (4,776,415) does show that the hydraulic pump (42) (Fig.

2) is for supplying pressured fluid to the hydraulic cylinders (34,36) to provide the extended position as shown in figure 1.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 15, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Brice's apparatus (4,776,415) in view of Ward's apparatus (5,359,942).

Brice's apparatus (4,776,415), as presented in section 7 above, shows a pair of hydraulic cylinders (34,36), but does not clearly show that *the hydraulic cylinder is a hydraulic motor*. However, Ward's apparatus (5,359,942), as presented in section 6 above, shows *the hydraulic cylinder having a double acting hydraulic motor* (see Col 5, lines 1-6).

Accordingly, it would have been obvious design choice to provide a hydraulic motor on the Brice's apparatus (4,776,415) as taught by Ward's apparatus (5,359,942) to provide a reliable hydraulic system capable of operating extended position or extracted position.

Allowable Subject Matter

10. Claims 1-12,21, and 22 are allowed.

Re claims 1 and 8, Ward's apparatus (5,359,942) or Brice's apparatus (4,776,415) does not show *a hydraulic cylinder on the device suspended from the crane and a manually operated control switch located at the device suspended from the crane for transmitting from the power source to the pump* in combinations with other structural limitations.

Re claim 17, Ward's apparatus (5,359,942) shows a pneumatic power supply which is a primary source of power being provided for operation of hopper gate doors on a hopper car. In the application of the Ward's invention, the available pneumatic power supply is converted to a hydraulic power (Col 2, lines 38-65) and for the hydraulic system, an air motor, connected to the pneumatic power source, drives a hydraulic pump to convert pneumatic power to hydraulic power (see Col 12, lines 66-68). However, Ward's apparatus (5,359,942) does not show *an electric motor and it would not have been obvious to replace the air motor with an electric motor to drive the hydraulic pump. The replacement of an electric motor would render Ward's apparatus unsatisfactory for its intended purpose.* If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir.1984)

Response to Arguments

11. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Applicant's amendment (*the addition of new limitations on claims 1,8, and 13 in combination with other structural limitations*) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL T. CHIN whose telephone number is (703) 305-1524. The examiner can normally be reached on MON-THURS (7:30 -6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EILEEN LILLIS can be reached on (703) 308-3248. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3652

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, reading "Paul Chin", with a small mark above the "i".

PAUL T. CHIN
Examiner
Art Unit 3652

July 9, 2004